

REMARKS

This application has been reviewed in light of the Office Action mailed on June 09, 2003. Claims 2-4, 6 and 8-16 are pending in this application with Claims 2, 6, 9 and 10 being in independent form. By means of the present amendment, Claims 10, 15 and 16 have been amended.

In the Office Action, claims 10-14 were rejected under 35 U.S.C. §102 (b) as being anticipated by European Patent Application No. EP0 825 791 (BT). Claim 10 recites the following steps:

- I. transmitting capabilities of said fixed terminal to a mobile terminal;
- II. selecting by said mobile terminal, parameters that match said capabilities and transmitting said parameters to said fixed terminal;
- III. selecting by said fixed terminal a portion of said parameters to form selected parameters and informing said mobile terminal of said selected parameters; and
- IV. transmitting by said mobile terminal to said fixed terminal required information to form said profile based on said selected parameters.

Regarding step I, *transmitting capabilities of said fixed terminal to a mobile terminal*, the Examiner asserts that this step is taught by BT and cites col. 5, lines 18-20 in support of his assertion. Col. 5, lines 18-20 of BT recites:

When a call is set up, the base station 10 transmits a signal 304 indicating its capabilities to the mobile telephone 1 (step 204). [Emphasis Added]

However, it is noted that the reference further teaches at lines 20-24 that

This can be done by transmission of an identifier indicative of the coding program proposed for use. If the base station can operate using any of several coding programs, it signals its preferred mode (usually the most efficient).

The coding program referred to in BT is a codec program for performing a coding operation. Codec programs are essentially algorithms that compress and decompress multimedia data. There are numerous standard codec schemes. Some are used mainly to minimize file transfer time, and are employed on the Internet. Others are intended to maximize the data that can be stored in a given amount of disk space, or on a CD-ROM. By contrast, in Claim 10, the term “capabilities” refers to the actual functions which are executed when a communication link is used. See the specification at page 8, lines 1-5 wherein it is stated that the capabilities include modulation type, bit rate, spreading codes (CDMA), number of carriers (OFDMA), etc as well as the ability to accept new functions, e.g., new modulation schemes.

Independent Claim 10 has been amended herein to better define Applicant’s invention over BT. Claim 10 recites limitations and/or features which are not disclosed by BT.

Claim 10 as amended herein recites:

transmitting capabilities of said fixed terminal to a mobile terminal, said capabilities including functions such as modulation type, bit rate, spreading code and number of carriers which are executed in a communication link;

It is respectfully submitted that at least the limitations and/or features of Claim 10 which are underlined above are not disclosed or suggested by BT.

Regarding step II, *selecting by said mobile terminal, parameters that match said*

capabilities and transmitting said parameters to said fixed terminal. The Examiner asserts that this step is taught by BT and cites col. 5, lines 35-45 in support of his assertion. Col. 5, lines 35-45 of BT recites:

On recognition of the identifier 304 by the monitor 4 of the mobile telephone 1 (step 104), the controller 2 of the mobile telephone 1 checks whether the identifier 304 corresponds to one already stored in the memory 7. If such an identifier is found, for example in identifier store 8ai, it indicates that the mobile telephone 1 should operate according to the program corresponding to that identifier, in this example 8ap, also stored in the memory 7. The controller 6 then causes the signal generator 5a to signal an acknowledgement 305 to the base station (step 105).

Applicants respectfully submit that BT does not teach or suggest the second step II of Claim 10 directed to *selecting by said mobile terminal, parameters that match said capabilities and transmitting said parameters to said fixed terminal.* In BT what is transmitted back is simply an acknowledgement signal (see underlined above) and not parameters that match said capabilities, as recited in Claim 10 at step II.

Accordingly, it therefore follows that BT further does not teach or suggest the following step, i.e., step III of Claim 10 directed to *selecting by said fixed terminal a portion of said parameters to form selected parameters and informing said mobile terminal of said selected parameters.* Given that BT does not teach step II directed to the transmission of parameters, it logically follows that BT cannot teach the following step, i.e., step III of selecting a subset of those parameters.

For the reasons given above, BT does not anticipate the subject matter of Claim 10. Accordingly, applicants respectfully request that the rejection under 35 U.S.C. §102(b) with respect to Claim 10 and allowance thereof is respectfully requested.

Additionally, Claims 11-14 depend from independent Claim 10 and therefore contain the limitations of Claim 10. Hence, for at least the same reasons given for Claim 10, Claims 11-14 are believed to be allowable over BT. Accordingly, withdrawal of the rejection under 35 U.S.C. §102(b) with respect to Claims 11-14 and allowance thereof is respectfully requested.

In the Office Action, claim 9 was rejected under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent No. 6,144,849 issued to Nodoushani et al. on November 7, 2000 ("Nodoushani et al.").

It is respectfully submitted that Nodoushani et al. does not disclose or suggest Applicant's invention as recited by independent Claim 9. In the Office Action the Examiner asserts that Nodoushani teaches a fixed terminal for use in a communication system in which a mobile terminal can configure said fixed terminal by service negotiation, the fixed terminal comprising a transceiver 24 (fig. 2), a memory for storing software functions 34 (fig. 2), and a processor for controlling operation of the fixed terminal in accordance with stored software functions 32 (fig. 2).

Nodoushani et al. teaches a conventional configuration with telephone calls being routed between mobile telephone units 26 and the PTSN 14 through MSC 16 and RF units 22. In the Office Action, at page 4, the Examiner states that the fixed terminal (for which no numerical designation is provided) comprises elements 24, 34 and 32, as allegedly shown in FIG. 2. It can therefore be fairly presumed that the respective elements are shown as part of a single fixed terminal structure. Upon reviewing FIG. 2, however, there is shown element 24 emanating from MSC 16. It is therefore presumed by the Applicant's that the "fixed terminal" structure being referred to by the Examiner is the

MSC. Based on this reasonable assumption, the MSC should also include elements 34 and 32, which it does not. Instead Internet platform 32 and OTASP software 34, which the Examiner equates to stored software functions and memory, respectively, are shown separated from the MSC by SS7 network 12. As such, elements 24 and 32 could not comprise a single fixed terminal device.

As a further distinction, Nodoushani et al. is directed to a method and apparatus for over-the-air service provisioning of a mobile telephone (See col. 1, lines 19-22 of Nodoushani et al.), and not a fixed terminal, as recited in Claim 9.

For the reasons given above, the cited reference does not anticipate the subject matter of Claim 9. Accordingly, applicants respectfully request that the rejection under 35 U.S.C. §102(b) with respect to Claim 9 and allowance thereof is respectfully requested.

Claims 2-4, 6 and 8 were rejected under 35 U.S.C. § 103(a) over BT (EP 0 874 529 A2) and Nodoushani et al.(U.S. Patent No. 6,144,849) in view of Niska et al. (U.S. Patent 6,041,228) ("Niska et al.").

It is respectfully submitted that BT and Nodoushani in view of Niska et al. does not disclose or suggest Applicant's invention as recited by independent Claims 2 and 6.

In rejecting Claim 2, the Examiner correctly noted that the combination of BT and Nodoushani do not teach a fixed terminal receiving a message and configuring itself in accordance with the received parameters. Niska is cited in attempt to remedy this deficiency. It is respectfully submitted that Niska does not show a fixed terminal receiving a message and configuring itself in accordance with received parameters. Rather, Niska merely shows that the base station introduces itself to the network by informing the network about its capabilities. There is no teaching or disclosure in Niska at col. 3, lines

42-46 of a fixed terminal (base station) configuring itself in accordance with received parameters, as recited in Claim 2. Niska, at Col. 3 lines 42-46, teaches that *configuration and upgrades can be accomplished much more easily by pre-programming the base station to introduce itself to the Network by informing the Network about its capabilities*. Thus, Niska teaches away from the present invention by teaching a configuration method in which the base station transmits parameters to the network, as opposed to receiving them, as recited in Claim 2.

For the reasons given above, the cited references, alone or in combination, do not anticipate the subject matter of Claim 2. Accordingly, applicants respectfully request that the rejection under 35 U.S.C. §103(a) with respect to Claim 2 and allowance thereof is respectfully requested.

Additionally, Claims 3 and 4 depend from independent Claim 2 and therefore contain the limitations of Claim 2. Hence, for at least the same reasons given for Claim 2, Claims 3 and 4 are believed to be allowable over the cited references. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) with respect to Claims 3 and 4 and allowance thereof is respectfully requested.

Claim 6 recites similar subject matter as Claim 2 and is believed to be in condition for allowance for at least the same reasons given for Claim 2.

Additionally, Claim 8 depends from independent Claim 6 and therefore contain the limitations of Claim 6. Hence, for at least the same reasons given for Claim 6, Claim 8 is believed to be allowable over the cited references. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) with respect to Claims 6 and 8 and allowance thereof is respectfully requested.

Claims 15 and 16 were rejected under 35 U.S.C. § 103(a) over BT (EP 0 874 529 A2) in view of (U.S. Patent No. 6,144,849) in view of U.S. Patent 6,112,206 issued to Morris ("Morris et al.").

Claims 15 and 16 recite similar subject matter as Claim 10, and are believed to be in condition for allowance for at least the same reasons given for Claim 10 as amended.

Claim 15 as amended recites:

means for transmitting capabilities of said communication terminal to another terminal, said capabilities including functions such as modulation type, bit rate, spreading code and number of carriers which are executed in a communication link;

Claim 16 as amended recites:

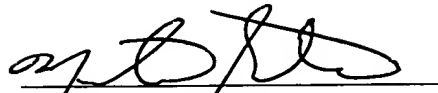
A transmitter transmits said capabilities to another terminal, said capabilities including functions such as modulation type, bit rate, spreading code and number of carriers which are executed in a communication link;

For the reasons given above, the cited references, alone or in combination, do not anticipate the subject matter of Claims 15 and 16. Accordingly, applicants respectfully request that the rejection under 35 U.S.C. §103(a) with respect to Claims 15 and 16 and allowance thereof is respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 2-4, 6 and 8-16 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Dico Halajian, Esq., Intellectual Property Counsel, Philips Electronics North America Corp., at 914-333-9607.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael A. Scaturro', written over a horizontal line.

Michael A. Scaturro
Reg. No. 51,356
Attorney for Applicant

Mailing Address:
Intellectual Property Counsel
Philips Electronics North America Corp.
580 White Plains Road
Tarrytown, New York 10591